

PATENT EXAMINATION BOARD

SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

SOUTH AFRICAN DESIGN LAW AND PRACTICE 2024 – GROUP 1(c)

Paper 1 of 1

27 June 2024

Examiner: C. Jackson

Moderator: H. van Schalkwyk

Time: 4 Hours (240 minutes)

Total marks: 100

This paper consists of 15 pages (including this cover page and 2 annexures marked “A” and “B”, respectively)

Instructions:

- This is a **closed-book examination**. No study or reference material is allowed into the examination venue.
- Answer all the questions.
- Write legibly. Answers that cannot be read will not be awarded marks.
- Answers for multiple choice questions 1 to 5 must state only the letter of the selected answer. Additional writing will result in a zero mark for the answer.
- All other answers must be answered using full sentences.

QUESTION 1

Your firm filed the application for South African Functional Registered Design no. F2023/061 on behalf of the proprietor. A corresponding European Registered Community Design was filed on 20 April 2023. The South African application was filed on 5 May 2023 declaring a release date of 8 January 2023. Your firm received the notice of registration on 17 December 2023. Registration of F2023/061 was published in the Patent Journal on 28 February 2024.

Choose the correct option out of (a) to (e) below:

- a. The first renewal fee for F2023/061 falls due on or before 28 February 2027.
- b. The first renewal fee for F2023/061 falls due on or before 20 April 2026.
- c. The first renewal fee for F2023/061 falls due on or before 17 December 2026.
- d. The first renewal fee for F2023/061 falls due on or before 8 January 2026.
- e. The first renewal fee for F2023/061 falls due on or before 5 May 2026.

[3]

QUESTION 2

Your firm filed the application for South African Aesthetic Registered Design no. A2023/00564 on behalf of the proprietor. The South African application was filed on the same day as Australian design application no. AU202310523. Australia amended its Designs Act effective from 10 March 2022 to provide a 12-month novelty grace period. The application for A2023/00564 was filed in South Africa on 6 September 2023, and your firm received the notice of registration on 14 February 2024. Registration of A2023/00564 was published in the Patent Journal on 24 April 2024.

Choose the correct option out of (a) to (e) below:

- a. Assuming all renewal fees are paid, A2023/00564 will reach the end of its duration and expire on 10 March 2037.
- b. Assuming all renewal fees are paid, A2023/00564 will reach the end of its duration and expire on 6 September 2038.
- c. Assuming all renewal fees are paid, A2023/00564 will reach the end of its duration and expire on 6 September 2033.
- d. Assuming all renewal fees are paid, A2023/00564 will reach the end of its duration and expire on 24 April 2034.
- e. Assuming all renewal fees are paid, A2023/00564 will reach the end of its duration and expire on 14 February 2039.

[3]

QUESTION 3

Your firm filed the application for South African Aesthetic Registered Design no. A2021/00776 on behalf of the proprietor. The South African application was filed on 16 April 2021. The application claims priority from Canadian design application no. CA2020-3354 filed on 30 December 2020. The proprietor made the design available to the public on 1 January 2021 by posting it on his Instagram profile as part of a New Year's product launch. Notice of registration was received on 9 August 2021, and the registration was advertised in the Patent Journal on 29 September 2021.

Your firm is responsible for paying the renewal fees for A2021/00776. However, your client indicated a few months ago that they are not interested in renewing the design. Today, 27 June 2024, your client calls you excitedly to say they have a person interested in purchasing A2021/00776 from them.

You inform your client as follows (Choose the correct option out of (a) to (i) below):

- a. A2021/00776 already lapsed on 30 December 2023 and therefore cannot be renewed.
- b. A2021/00776 already lapsed on 30 December 2023, but can be restored and then renewed.
- c. A2021/00776 will lapse on 30 June 2024 and can therefore be renewed.
- d. A2021/00776 already lapsed 1 January 2024 and therefore cannot be renewed.
- e. A2021/00776 already lapsed 1 January 2024, but can be restored and then renewed.
- f. A2021/00776 will lapse on 1 July 2024 and can therefore be renewed.
- g. A2021/00776 will lapse on 16 April 2024.
- h. A2021/00776 will lapse on 16 October 2024.
- i. A2021/00776 will lapse on 29 September 2024.

[3]

QUESTION 4

The Intellectual Property Laws Amendment Act 28 of 2013 introduced the concept of "traditional designs". Consider the accuracy of the following definitions relating to such traditional designs.

- i. An indigenous design means an aesthetic or functional design with an indigenous or traditional origin and a traditional character, including indigenous cultural expressions or knowledge which was created by persons who are or were members, currently or historically, of an indigenous community and which design is regarded as part of the heritage of the community.
- ii. An aesthetic indigenous design refers to an indigenous design applied to an article for the pattern or the shape or the configuration or the ornamentation thereof, of for two or more of those purposes, and by whatever means it is applied, having features which appeal to and are judged solely by the eye, irrespective of the aesthetic quality thereof.
- iii. A functional indigenous design refers to an indigenous design applied to an article for the pattern or the shape or the configuration thereof, or for two or more of those purposes, and by whatever means it is applied, having features which are necessitated by the function which the article to which the indigenous design is applied, is to perform and includes an integrated circuit topography, a mask work and a series of mask works.
- iv. A derivative indigenous design means any aesthetic or functional design applied to any form of indigenous design recognised by an indigenous community as having an indigenous or traditional origin, and a substantial part of which was derived from indigenous cultural expressions or knowledge, and which was derived after the commencement of the Intellectual Property Laws Amendment Act.
- v. An indigenous design expires after 15 years.

Choose the correct option from (a) to (g) below:

- a. All of statements (i) to (v) are correct.
- b. None of statements (i) to (v) are correct.
- c. Only statement (i) is correct.
- d. Only statements (i) and (v) are correct.
- e. Statements (i), (ii), and (iv) are correct.
- f. Statements (i) and (ii) are correct.
- g. Only statement (v) is correct.

[3]

QUESTION 5

Case law provides interpretation of the Designs Act. Consider the statements below regarding the question of law considered in the cited cases.

- A) Chespak v MCG Industries confirmed that prior art cannot be mosaiced.
- B) Homecraft Steel Industries v SM Hare & Son confirmed that the ambit of a monopoly afforded by a registered design is determined by the measure of novelty of the design.
- C) Clipsal Australia v Trust Electrical Wholesalers confirmed that, for a definitive statement in the omnibus form, a narrow interpretation of the scope of protection must be given.
- D) Bress Designs v GY Lounge Suite Manufacturers confirmed that the registrability requirement of the article being “intended to be multiplied in an industrial process” is not limited to automated machinery.
- E) BMW v Grandmark confirmed that spare parts for vehicles can be filed as “aesthetic designs” because they serve to restore the appearance of a vehicle, i.e. that which is judged solely by the eye, to its original condition.

Choose the correct option out of (a) to (g) below:

- a. None of the above are correct.
- b. All of the above are correct.
- c. Only (E) is correct.
- d. Statements (B) and (C) are incorrect.
- e. Statements (A) and (E) are correct.
- f. Statements (B) and (D) are correct.
- g. Only (D) is correct.

[3]

QUESTION 6

What does the state of the art comprise in terms of the Designs Act?

[7]

QUESTION 7

Now apply your answer in question 6 to the following facts and confirm whether the relevant subject matter forms part of the state of the art, providing a brief explanation.

- (a) United States utility patent application filed on 1 September 2023. The application is still pending and has not yet been published.
- (b) United States design patent filed on 1 September 2023, with a corresponding design application filed in South Africa on 1 March 2024. Neither of these applications have been published yet.

[4]

QUESTION 8

What is the effect of a registered design?

[6]

QUESTION 9

The Designs Act makes provision for an interested person to apply to court for the granting of a compulsory licence if the rights in a registered design are being abused.

Provide any two conditions under which a registered design shall be deemed to be abused according to the Act?

[4]

QUESTION 10

The Act provides that designs for articles which are not intended to be multiplied in an industrial process shall not be registrable (as registered designs). What is meant by “multiplied in an industrial process”? Cite case law and explain the implication thereof on hand-made articles.

[4]

QUESTION 11

Give the complete definitions of:

- A) A functional design (3)
- B) An aesthetic design (3)
- C) A set of articles (4)

[10]

QUESTION 12

Following on Question 11 above, explain what meaning is attributed to each of the protectable features of an aesthetic design.

[4]

QUESTION 13

Your client is the registered proprietor of an aesthetic registered design for a shopping trolley as shown in Figure 1 below, which they manufacture and supply to a specific retailer. They have recently become aware of another retailer, Jumbo Foods, that uses a trolley that appears almost identical to theirs. After consulting with your client, you sent a letter of demand to Jumbo Foods demanding, amongst other things, that they immediately cease infringing your client's registered design.

In their response, Jumbo Foods refuses to comply with your client's demands. They contend that the trolley is a purely functional article, and that your client's aesthetic design therefore affords them no protection.

Advise your client regarding the strength of Jumbo's defence citing case law.

[5]



Figure 1

QUESTION 14

Your client, “Out and About”, sells footwear such as sneakers. Out and About have been advertising their new sneaker on their Instagram account in anticipation for their launch in two months’ time. They have just received a letter of demand stating that they are infringing the registered design of another footwear company, “Trample”. Trample’s letter of demand states that they will institute infringement proceedings against Out and About if they do not immediately cease infringing Trample’s registered design and surrender all their stock of the new sneaker to Trample for destruction within 1 week.

Upon further investigation, you note that Trample’s registered design was filed 2 months ago and is still pending.

Trample made a public statement and published the letter of demand on their Instagram page. Almost immediately, Out and About lost 20% of their followers on Instagram, which is sure to impact their sales.

Advise Out and About what remedies they have at their disposal.

[4]

QUESTION 15

It now emerges that your client from Question 14 above, Out and About, have not yet made, used, sold, or imported any of their new sneakers. They have merely been advertising computer renderings to create some anticipation in the market. However, they have spent considerable resources preparing to launch the new sneaker. They concede that their new sneaker is substantially similar to that of Trample, and that Trample will therefore be able to restrain them from commercialising their new sneaker once Trample’s design proceeds to registration.

Advise Out and About what remedies they have at their disposal.

[3]

QUESTION 16

The registration of South African registered design no A2022/01166 was advertised in the Patent Journal of December 2023, and is entitled “ICONS”. As the extract of the publication indicates, the design is registered in class 14, which Schedule 3 to the Regulations indicates is for “Recording, communication or information retrieval equipment”, including “screen displays and icons”.

Schedule 3 also includes class 32, which is for “graphic symbols and logos, surface patterns, ornamentation”, and appears to have a wider scope than that of class 14. Why would the proprietor have filed the application in class 14, rather than the wider class 32.

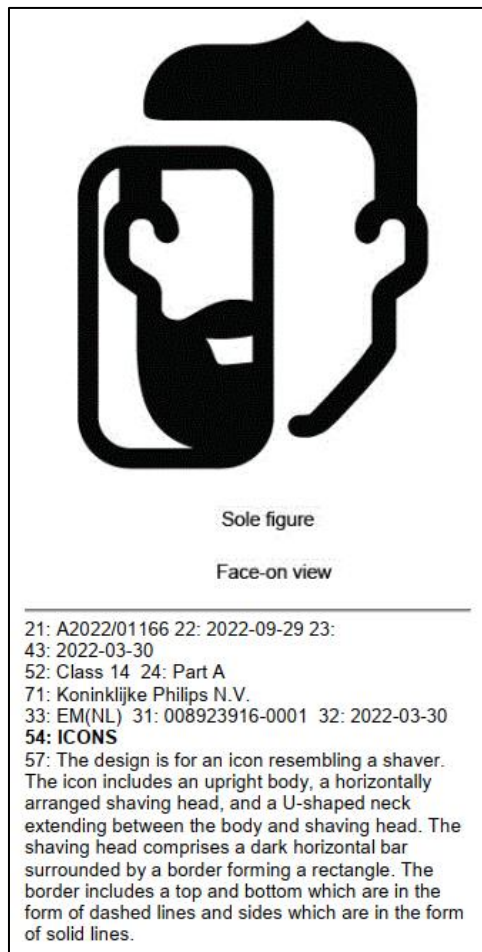


Figure 2

[3]

QUESTION 17

The definitive statement of a particular registered design reads as follows:

The features of the design for which protection is claimed are those of the shape or configuration of a bottle, substantially as shown in the accompanying representations. Features shown in broken lines do not form part of the design and are disclaimed.

Comment on the allowability of an amendment that:

- a) Amends the definitive statement to read: "...the shape and configuration...";
- b) Removes the disclaimer to the features shown in broken lines from the definitive statement;
- c) Adds in a pattern on the drawings of the bottle that the draughtsman forgot to draw in.

[6]

QUESTION 18

The Designs Act provides that, where a design registration has lapsed owing to non-payment of renewal fees, application may be made for its restoration in the prescribed manner.

- a) State and briefly explain or exemplify the criteria that must be satisfied to be eligible for restoration?
- b) Briefly explain what the prescribed manner is in which the application for restoration must be made.

(4)

(4)

[8]

QUESTION 19

You consult with a new client, Pearly Whites (Pty) Ltd. They are the exclusive licensee, duly recorded on the register, of South African registered design number A2019/02353 for a toothbrush. An illustrative representation of the registered design is shown in Figure 3 below.

In terms of Pearly Whites' licence agreement with the registered proprietor, BetterBristles (Pty) Ltd, Pearly Whites have the exclusive right to make, import and sell toothbrushes as shown in Figure 3 in South Africa. The licence agreement also places an onus on Pearly Whites to enforce the registered design, should infringement occur.

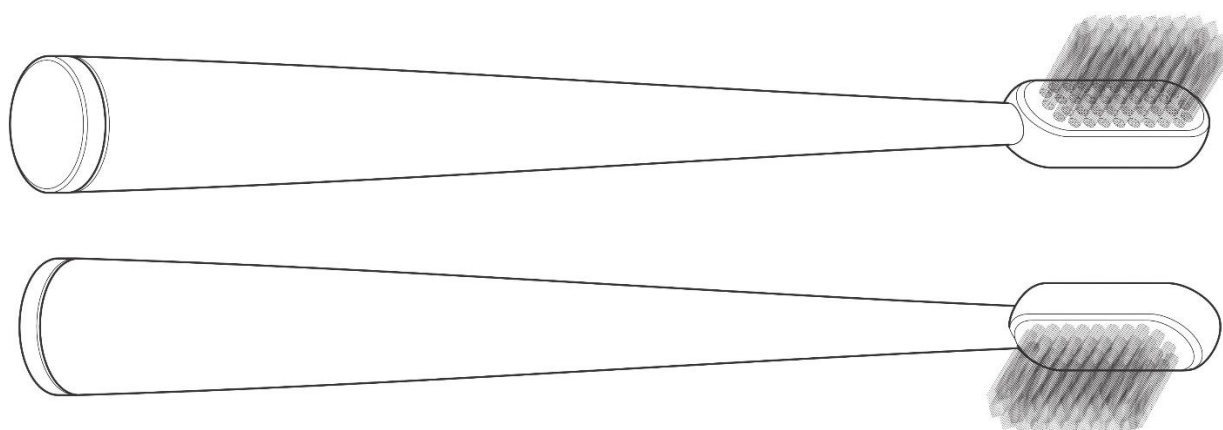


Figure 3: Registered design

Pearly Whites have recently become aware of a toothbrush being commercialised by a competitor, FangScrub CC, as shown in Figure 4 below. An activewear-clad influencer called Roxy Dentin featured the FangScrub toothbrush on her Instagram page last week. Pearly Whites proceeded to order a few of these toothbrushes from FangScrub's website using Roxy's discount code as a test purchase.

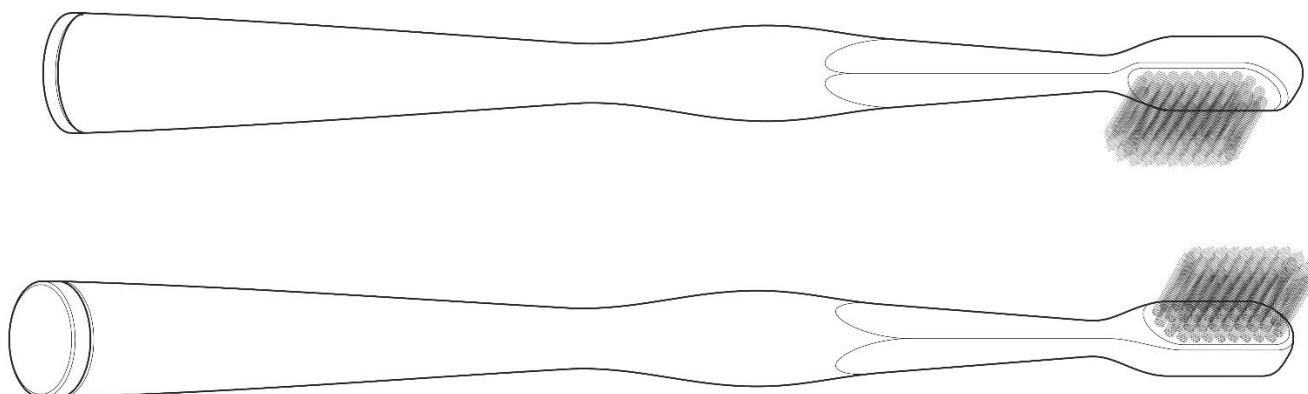


Figure 4: FangScrub's toothbrush

Pearly Whites wants an opinion from you whether FangScrub infringes their registered design before instituting infringement proceedings.

As a first step you have obtained a copy of the designs register sheet, Form D2, shown in Annexure “A”, as well as a copy of Form D6 shown in Annexure “B”. A prior art search also reveals the prior art toothbrush shown in Figure 5. The prior art toothbrush was unearthed in an archaeological dig in Peru, with carbon dating putting it at 3000 B.C.

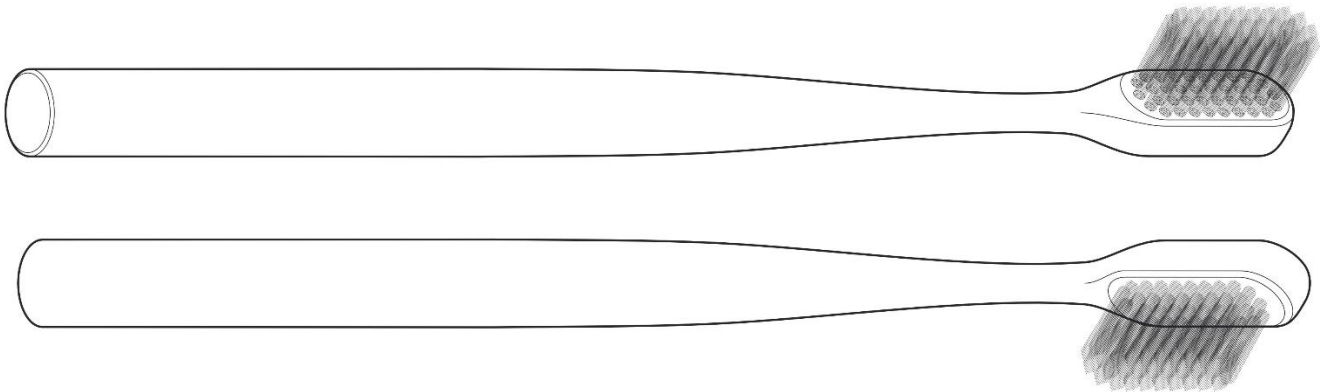


Figure 5: Closest prior art

In light of these facts, advise Pearly Whites as to whether, in your opinion, FangScrub infringes the registered design, and provide them with any related observations you deem necessary to point out.

[17]

TOTAL: [100]

Three annexure pages to follow

REPUBLIC OF SOUTH AFRICA

DESIGNS ACT, 1993

REGISTER OF DESIGNS

Official Application No:
A2019/02353

Date of Lodgement:
6 June 2019

Classification
04 (Brushware, including toothbrushes)

Applicant(s):
BetterBristles (Pty) Ltd 7 Enamel Street, Cape Town

Type of design Part A Part F

Release date (if applicable): N/A

PRIORITY CLAIMED	COUNTRY	NUMBER	DATE

Article to which design is to be applied: **TOOTHBRUSH**

ADDRESS FOR SERVICE

The IP Firm

Docex 11, Cape Town

P O Box 113, Cape Town

1001, South Africa

RENEWALS			
Year	Date Paid	Receipt	Penalty
4	1 June 2022	RD2022-00056	
5	2 June 2023	RD2023-02124	
6			

Licences, assignments, attachments, etc.			
Nature	In favour of	Date registered	Date cancelled
Exclusive	Pearly Whites (Pty) Ltd	10 March 2020	

History	
Date	Description
6 Jun 2019	Application for the registration of a design, allocated (application) number A2019/02353
5 Feb 2020	Design registration entered
10 Mar 2020	Licence recorded
29 Apr 2020	Registration advertised in Patent Journal
1 Jun 2022	Renewal payment made by The IP Firm
2 Jun 2023	Renewal payment made by The IP Firm

REPUBLIC OF SOUTH AFRICA

DESIGNS ACT, 1993

DEFINITIVE STATEMENT AND EXPLANATORY STATEMENT

(Regulation 15)

Official Application No:	Date of Lodgement:
A2019/02353	6 June 2019

Full name(s) of applicant(s):
BetterBristles (Pty) Ltd

Classification: **04 (Brushware, including toothbrushes)**Articles to which design is to be applied: **TOOTHBRUSH**Release date (if applicable): **N/A**Type of design Part A Part F

Definitive statement:

The features of the design for which protection is claimed are those of the shape and/or configuration and/or pattern and/or ornamentation of a toothbrush substantially as shown in the accompanying representations.

Explanatory statement:

(None)

Address for service:

The IP Firm

Docex 11, Cape Town

P O Box 113, Cape Town

1001, South Africa